

REMARKS

By this Amendment, claims 1, 2 and 4 are amended merely to clarify the recited subject matter. Applicants note that support for the amendment to claim 1 may be found in the specification generally, and particularly in paragraphs [0022] and [0041] of the specification. Claims 1-14 are pending; however, claims 5-14 have been withdrawn from consideration.

The Office Action rejected claims 1-4 under 35 U.S.C. 112, second paragraph, for allegedly being indefinite. Applicants submit that the amended claims are fully compliant with the requirements of 35 U.S.C. 112. Therefore, the rejection is traversed.

The Office Action rejected claims 1-4 under 35 U.S.C. 103 as being unpatentable in view of Berthold (U.S. 3,624,444). Applicants traverse the rejection because Berthold fails to disclose, teach or suggest all the features recited in the rejected claims. For example, Berthold fails to disclose, teach or suggest the claimed ultraviolet ray lamp including “an optical filter including a metal oxide, which is formed on part of the outer surface of the discharge vessel, transmitting ultraviolet rays having a wavelength of 254 nm or more and blocking ultraviolet rays having a wavelength of 185 nm or less,” as recited in independent claim 1 and its dependent claims 2-4.

As recognized by the outstanding Office Action, Berthold fails to teach a metal oxide filter formed on part of the outer surface of a discharge vessel. However, the Office Action asserted that including such a metal oxide coating would have been obvious because “it could be provided at any suitable location for filtering the ultraviolet rays...”

Nevertheless, the Office Action has failed to establish a *prima facie* case of obviousness because the Office Action has failed to identify the suggestion or motivation, either in Berthold or in the knowledge generally available to one of ordinary skill in the art, to modify the express teachings of Berthold as hypothesized by the Office Action. Obviousness can only be established by modifying the teachings of Berthold to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Even assuming for argument’s sake that the Berthold device may be capable of being modified as speculated by the Office Action, there is no suggestion or motivation in Berthold for that modification.

The Office Action merely asserted that the Berthold device could be modified to include a metal oxide filter as claimed. However, there is no indication of why one of

ordinary skill in the art would have made such a modification. Therefore, the obviousness rejection fails for lack of a *prima facie* case. Accordingly, claims 1-4 are allowable.

Moreover, Applicants submit that the Berthold clearly fails to disclose, teach or suggest the claimed ultraviolet ray lamp including an optical filter including a metal oxide, which is formed on part of the outer surface of the discharge vessel, “transmitting ultraviolet rays having a wavelength of 254 nm or more and blocking ultraviolet rays having a wavelength of 185 nm or less.” Because Berthold fails to disclose, teach or suggest any metal oxide coating at all, Berthold also fails to disclose, teach or suggest the particular characteristics of such a coating, as recited in the rejected independent claim 1 and dependent claims 2-4. Accordingly, claims 1-4 are allowable.

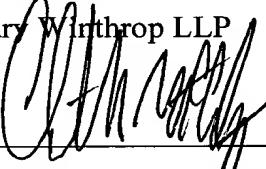
All rejections and objections have been addressed. It is respectfully submitted that the present application is now in condition for allowance, and a notice to that effect is earnestly solicited. Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

Pillsbury Winthrop LLP

By: \_\_\_\_\_

  
Christine H. McCarthy  
Reg. No.: 41,844  
Tel. No.: (703) 905-2143  
Fax No.: (703) 905-2500

September 1, 2004

1600 Tysons Boulevard  
McLean, VA 22102  
(703) 905-2000